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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,933	06/20/2001	Olivier Attia		3723

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SCANBUY, INC.
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NEW YORK, NY 10018

EXAMINER

RHODE JR, ROBERT E

ART UNIT PAPER NUMBER

3625

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,933

Applicant(s)

ATTIA, OLIVIER

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 6, 7, 9, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 6, 7, 9, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant amendment of 9 27-05 did not amend any claims and traversed rejections of Claims 4, 6, 7, 9, 17 and 18.

Currently, claims 4, 6, 7, 9, 17 and 18 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 4 for example, the phrase "personalized catalogs" is a relative phrase, which renders the claims indefinite. The phrase "personalized catalogs" is not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes, the phrase "personalized catalogs" will be treated as a customized wish list and the ability to store multiple wish lists.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6, 7, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (US 6,651,053 B1) in view of Walsh (6,144,848) and further in view of Knowlton (US 6,061,057).

Regarding claim 17 and related claims 4 and 18, Rothschild teaches a method for facilitating online ordering comprising the steps of: scanning a plurality of barcodes using a barcode scanner; uploading said barcodes into a centralized repository; Resolving each barcode into a product identifier using a product database located on said central repository; storing the resolved information in the repository in the form of customized shopping lists, these customized wish lists with associated products can be stored and utilized for reorder (see at least Abstract, Col 3, lines 60 – 67, Col 4, line 1 and lines 53 – 56, Col 7, lines 22 – 38 and Col 10, lines 55 - 58).

Although Rothschild's discloses UPC codes, ordering and searching internal and external data sources, the reference does not specifically disclose and teach a method for recommending a product substitute to a consumer if the product is not found in said

Art Unit: 3625

product database by querying internal and external repositories of product and manufacturer information based on Universal Product Codes'.

On the other hand and in the same area of online shopping using a portable device with bar code reader, Walsh teaches a method for recommending a product substitute to a consumer if the product is not found in said product database by querying internal and external repositories of product and manufacturer information based on Universal Product Codes (see at least Abstract, Col 3, lines 24 and 52 and Col 37, lines 21 - 45).

It would have been obvious to one of ordinary skill in the art to have provided the method of Rothschild with the method of Walsh to have enabled a method for recommending a product substitute to a consumer if the product is not found in said product database by querying internal and external repositories of product and manufacturer information based on Universal Product Codes. Rothschild discloses a method for facilitating online ordering comprising the steps of: scanning a plurality of barcodes using a barcode scanner; uploading said barcodes into a centralized repository (see at least Abstract and Col 7, lines 22 – 38). In turn, Walsh discloses a method for recommending a product substitute to a consumer if the product is not found in said product database by querying internal and external repositories of product and manufacturer information based on Universal Product Codes (see at least Abstract, Col 3, lines 24 and 52 and Col 37, lines 21 - 45). Therefore, one of ordinary skill in the art would have been motivated to extend the method of Rothschild with a method for

Art Unit: 3625

recommending a product substitute to a consumer if the product is not found in said product database by querying internal and external repositories of product and manufacturer information based on Universal Product Codes. In this manner, the added feature will provide additional products to order for the shopper, which will increase the probability for additional sales as well decreasing the time to search for substitute products.

The combination of Rothschild and Walsh disclose and teach substantially the applicant's invention.

However, the combination does not specifically disclose and teach a method for creating a shopping cart by dragging said shopping lists or items from said customized shopping lists and dropping them in said shopping cart; creating personalized catalogs from said shopping lists instantly wherein said personalized catalogs include product information of items within said shopping lists along with an associated barcode, wherein said personalized catalogs may be utilized to reorder items located in said catalog; transferring said shopping cart to an e-commerce website; and using said e-commerce website to order said items located in said shopping cart.

On the other hand and in the same area of online shopping with scan capability, Knowlton teaches a method for creating a shopping cart by dragging said shopping lists or items from said customized shopping lists and dropping them in said shopping cart;

creating personalized catalogs from said shopping lists instantly wherein said personalized catalogs include product information of items within said shopping lists along with an associated barcode, wherein said personalized catalogs may be utilized to reorder items located in said catalog; transferring said shopping cart to an e-commerce website; and using said e-commerce website to order said items located in said shopping cart (see at least Abstract, Col 12, lines 16 – 17, Col 14, lines 19 – 33 and 64 – 67, Col 15, lines 21 – 34 and 48 – 65).

It would have been obvious to one of ordinary skill in the art to have provided the combination of Rothschild and Walsh with the method of Knowlton to have enabled a method for creating a shopping cart by dragging said shopping lists or items from said customized shopping lists and dropping them in said shopping cart; creating personalized catalogs from said shopping lists instantly wherein said personalized catalogs include product information of items within said shopping lists along with an associated barcode, wherein said personalized catalogs may be utilized to reorder items located in said catalog; transferring said shopping cart to an e-commerce website; and using said e-commerce website to order said items located in said shopping cart. The combination of Rothschild and Walsh disclose a method for scanning barcodes, uploading barcodes storing the resolved information in customized shopping/wish list and recommending a substitute product. In turn, Knowlton discloses a method for creating a shopping cart by dragging said shopping lists or items from said customized shopping lists and dropping them in said shopping cart; creating personalized catalogs

Art Unit: 3625

from said shopping lists instantly wherein said personalized catalogs include product information of items within said shopping lists along with an associated barcode, wherein said personalized catalogs may be utilized to reorder items located in said catalog; transferring said shopping cart to an e-commerce website; and using said e-commerce website to order said items located in said shopping cart (see at least Abstract, Col 12, lines 16 – 17, Col 14, lines 19 – 33 and 64 – 67, Col 15, lines 21 – 34 and 48 – 65). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Rothschild and Walsh with a method for creating a shopping cart by dragging said shopping lists or items from said customized shopping lists and dropping them in said shopping cart; transferring said shopping cart to an e-commerce website; and using said e-commerce website to order said items located in said shopping cart. In this manner, the retail merchant will increase the probability for additional sales from their mortar sites, which are now more effectively linked with their online site.

Regarding Claim 6, Rothschild teaches a method for managing scan-based input, wherein said central repository is a server computer (Col 7, lines 23 – 24 and Col 8, line 18).

Regarding claim 7, the Examiner takes Official Notice that is old and well know that product database use relational databases.

Regarding claim 9, Knowlton method for managing scan-based input further including the step of: using billing information from a customer database to complete said online shopping (Col 15, lines 48 - 65).

Response to Arguments

Applicant's arguments filed 9-27-05 have been fully considered but they are not persuasive.

Applicant argues that the references separately do not disclose all the limitations of the Independent claims.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Rothschild does not disclose adding or deleting items after scanning, which provide customization.

While it is appropriate to use the specification to determine what applicant intends a term to mean, a positive limitation from the specification cannot be read into a claim that does not impose that limitation (MPEP 2106). Of note, there is no claim

recited limitations that includes the ability to edit functions such as delete, which provide customization.

Applicant argues that Walsh does not disclose a "method of performing product substitutions".

While it is appropriate to use the specification to determine what applicant intends a term to mean, a positive limitation from the specification cannot be read into a claim that does not impose that limitation (MPEP 2106). Of note, the recited claims limitations state "recommending a product substitute" and does not in any manner implied or can be interpreted to mean "performing product substitution".

Applicant argues that Knowlton does not disclose features of "drag and drop of entire list or items".

Please note that Knowlton does disclose "drag and drop" as well ordering (see above rejection). Of note, the use of reorder was recited in tentative language "may be utilized to reorder", which is taught by Rothschild.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3625

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

Art Unit: 3625

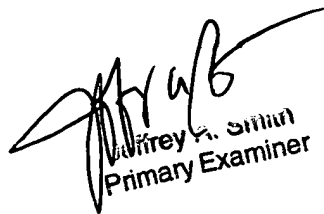
For general questions the receptionist can be reached at

571.272.3600

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Jeffrey A. Smith
Primary Examiner